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Appl. No. 09/992,537

Amendment B and Response to Office Action

**REMARKS**

Applicant submits that the subject application, as amended, is now in condition for allowance. Claims 1, 19 and 23 have been amended. Claims 2-18 were canceled in Amendment A dated May 22, 2006. Claims 1 and 19-25 are presented for examination.

**Rejection of Claims 1-17 Under 35 U.S.C. §103(a)**

Regarding claims 1 and 19-25. Applicant contends that the Office has not made out a *prima facie* case of obviousness. Three basic criteria must be met to establish a *prima facie* case of obviousness. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success to modify the reference or to combine reference teachings.

The Office Action rejects claims 1 and 19-25 under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 5,862,223 ("Walker") alone. By this Amendment, Applicant amends claims 1, 19 and 23, and Applicant respectfully disagrees with the conclusion of obviousness with respect to all of the pending claims.

Applicant respectfully submits that Walker does not disclose all of the elements of independent claims 1 and 19 as amended, and the Office has failed to show that the elements of claims 1 and 19 not disclosed by Walker would be known to a person having ordinary skill at the time the invention was made.

Specifically, the claimed invention calls for a "list of at least one preferred investigator." Although the Office contends that such a list is disclosed by Walker at col. 6, lines 58-61, Applicant disagrees. Walker discloses merely that a client may "certify and authenticate the expert's qualifications [and] ... hire the expert under specific terms and conditions for a specific assignment," but that is not the same as "selecting the investigator from the list of at least one preferred investigator" as claimed by the subject application. Ultimately, Walker discloses that a client provides only characteristics of a suitable expert, but the claims of the subject application

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call for the client to provide a "list of at least one preferred investigator," not merely characteristics.

Further, Walker does not disclose that such a list of at least one preferred investigator is received from the client. Essentially, Walker discloses providing the client with a list of qualified experts, based on characteristics defined by the client, from which to select, but that is not what is claimed by claims 1 and 19. Claims 1 and 19 call for a list of at least one preferred investigator to be provided by the client, not presented to the client.

In addition, Walker does not disclose that the assigned investigator is selected "from the list of at least one preferred investigator" or that "acceptance [of the case is received] from the investigator." While Walker discloses various methods for selecting the experts based on characteristics defined by the client (col. 37, lines 9-18, and Figs. 30-32), none of the various methods disclose selecting the investigator "from the list of at least one preferred investigator" received from the client. Moreover, in each disclosed embodiment of Walker, the end user is responsible for accepting the expert. By contrast, claims 1 and 19 of the subject application call for the investigator to accept the case of the user.

For at least these reasons, the 35 U.S.C. § 103(a) rejection with respect to claims 1 and 19-25 is unsupported and should be withdrawn.

### Conclusion

In view of the remarks above and the amendments presented herein, it is believed that claims 1 and 19-25 are in condition for allowance and notice to such effect is respectfully requested. If the Examiner thinks a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at the phone number provided below.

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A Credit Card Payment Form (PTO-2038) is enclosed herewith to authorize payment for the \$395.00 RCE filing fee and the \$510.00 extension of time fee. The Commissioner is authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-2051, identifying our Docket No. 29586-2.

Respectfully submitted,

Date: February 7, 2007

By:



Robert R. Lech  
Reg. No. 37,169

BENESCH, FRIEDLANDER  
COPLAN & ARONOFF LLP  
88 East Broad Street  
Suite 900  
Columbus, OH 43215-3506  
(614) 223-9366